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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,427	09/30/2005	Andrew David Miller	CU-4022 RJS	6762

26530 7590 03/08/2010  
LADAS & PARRY LLP  
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CHICAGO, IL 60604

EXAMINER
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PUTTLITZ, KARL J

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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03/08/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/518,427		MILLER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	KARL J. PUTTLITZ		1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-67 and 71-119 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-67 and 71-119 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/12/2010</u> .   | 6) <input type="checkbox"/> Other: _____.                         |

### **DETAILED ACTION**

The typo rejecting claims 1-119 is corrected below.

The rejection under section 112, second paragraph is maintained, in part, below:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

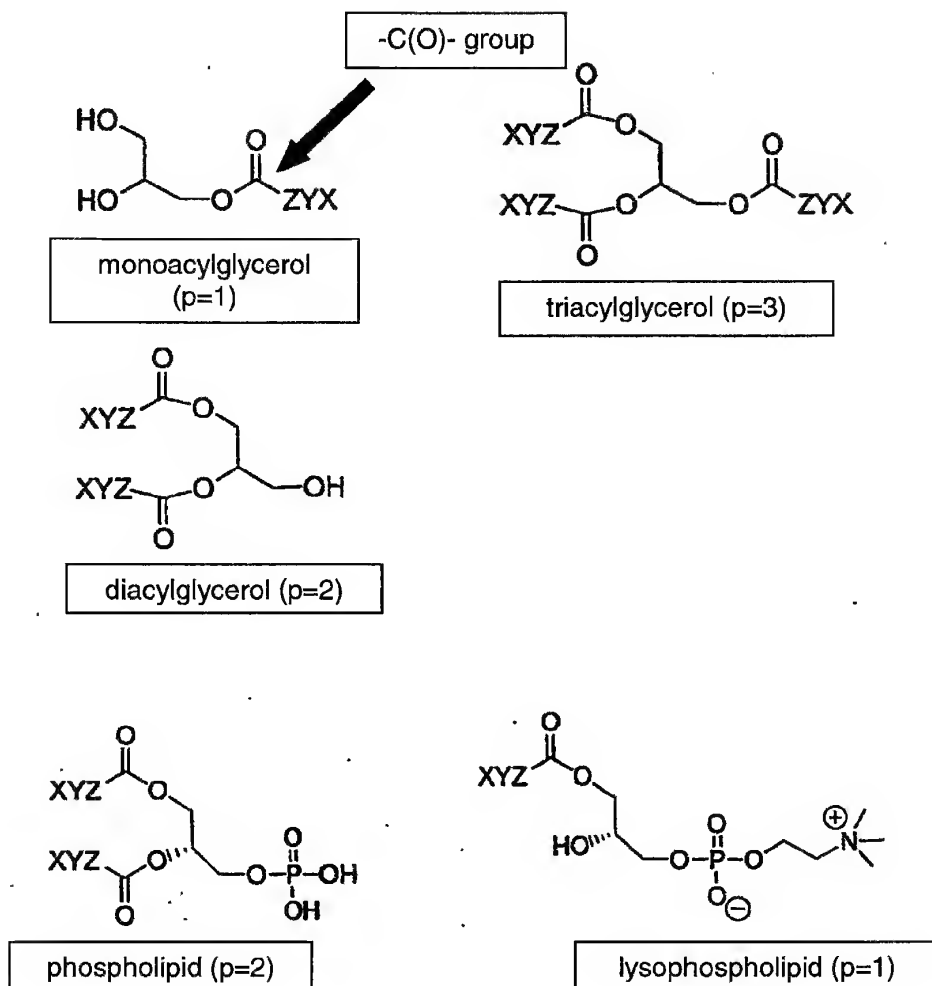
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 61-67, 71-119 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

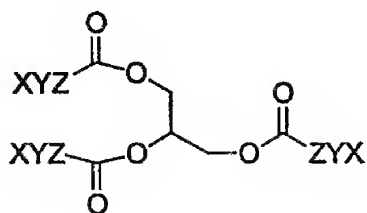
The structure of the compounds is still indefinite since it is unclear how the PHG groups are bound to the XYZ-C(O) group. Therefore the structure of the PHG group remains unclear.

Applicant argues that the rejection is erroneous since it is not informed by the examples given in the specification. In this regard, the examples in the specification clearly show that the XYZC(O) group is esterified to the hydroxyl groups of a glycerol residue. However, the claims do not require this. In this connection, Applicant is reminded that limitations of the specification are not to be read into the claims.

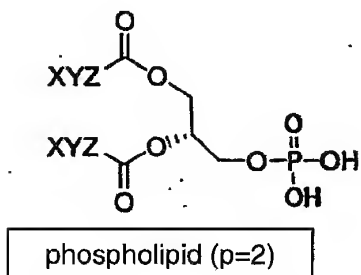
Moreover, the remarks indicate that the PHG can be some of the following:



However, these structures further confuse the issue of how the  $\text{XYZC(O)}$  groups can bind to the PHG group in situations such as when PHG triacylglycerol since, based on the above, the PHG group includes the  $\text{XYZC(O)}$  group, which is not recited in the claims. For example, the claims require that at least 1  $\text{XYZC(O)}$  group is bound to the PHG group. But how can one more  $\text{XYZC(O)}$  group fit into the recited compound if PHG is:



or



in the above all OH groups of the glycerol residue are occupied and another XYZC(O) group cannot bind. Therefore, it is unclear how another XYZC(O) group can bind in these situations.

Claim 99 has no steps. This is a new ground of rejection.

The rejection under section 11, first paragraph is maintained, below:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 61-82, 84-96, 98-101, 116-119 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims include the proviso: wherein Z is a C1-C6 alkyl group when Y is S and PHG is a phosphatidylethanolamine phospholipid or phosphatidylethanolamine lysophospholipid.

However, the specification does not include this sub-genus of compounds and thus the specification does not show that the inventor were in possession of this sub-genus.

Although Applicant's show support for the separate definitions of Z, Y, and PHG, the specification does not support the proviso Z is a C1-C6 alkyl group when Y is S and PHG is a phosphatidylethanolamine phospholipid or phosphatidylethanolamine lysophospholipid. This proviso creates a sub-genus of compounds that are not supported in the specification.

The following prior art rejections are withdrawn in favor of the following new grounds of rejection:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 61, 87, 98-101, 104, 112-114, 116-119 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5151534 (US 534) (counterpart to EP 0342115 in the IDS filed 1/12/2010).

US 534 teaches the following compound that can be esterified to polyhydroxy compounds (such as glycerols) see definitions of R and R<sub>1</sub>.

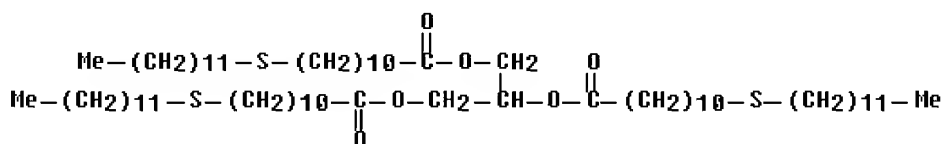


The compounds can be formulated as emulsions (liposomes) and inhibit formation of arachidonic acid (inflammation), see columns 7+.

After a further review of the prior art, the following new ground of rejection is now entered:

Claims 61 and 87 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al., Journal of the American Chemical Society (1957), 79, 753-4 (Johnson).

Johnson teaches the following compound that anticipates the rejected claims:



See attached DATABASE CAS citation 1957:51648 [retrieved 2 March 2010] on STN; Columbus, OH, USA.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan, can be reached at telephone number (571) 272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karl J. Puttlitz/

Primary Examiner, Art Unit 1621